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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,623	02/22/2002	Yoichiro Tanaka	219861USOPCT	7766

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EXAMINER	
MERCIER, MELISSA S	
ART UNIT	**PAPER NUMBER**
1615	

NOTIFICATION DATE	DELIVERY MODE
04/22/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/049,623	TANAKA ET AL.	
	Examiner	Art Unit	
	MELISSA S. MERCIER	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8,9,27,28 and 33-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-9, 27-28, 33-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Summary

Receipt of Applicants Remarks and Amended Claims filed on January 28, 2008 is acknowledged. Claims 8-9, 27-28, and 33-40 remain pending in this application. Rejections and/or objections not reiterated from previous Office Actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 8-9 and 27-28, and 33-40 rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka (JP-04-001118).

Tanaka describes a cosmetic characterized by a pressure-collapsible flexible resin capsule comprising a water and/or moisture-retaining powder. The pressure collapsible flexible resin capsules are designed in such a manner that their capsules become collapsed by the pressure applied by the fingers or a sponge during a make-up application so that the contained water and/or moisturizing content becomes released (page 6, last paragraph). On page 8, the last paragraph, a pressure-collapsible flexible resin capsule comprising water and a moisture-retaining ingredient is taught wherein the moisture-retaining ingredient is selected from a list of ingredients comprising xanthan

gum and carrageenan, which are included in the list of water-soluble gallants of the instant application. Tanaka also teaches that he ingredient is not limited to those descried in the patent and is only required to be soluble to water, alcohol, or polyhydric alcohol and to exhibit skin moisturizing properties.

The 2nd and 3rd paragraphs on page 9 further teach that the composition comprises a shell-forming resin, insoluble in water, comprised of an inorganic fine powder selected from a list of ingredients that include ultra fine particulates of anhydrous silica wherein the grain diameter of the powder is ½ or less of the capsule size, preferably about 0.01-2 pm ingredient. This disclosure reads on the required hydrophobic particles used to coat the gel core.

Absent from the cosmetic preparation taught by Tanaka is the freeze-shattering limitation as claimed in claims 23 and 29-32. However, there is no showing by way of working examples or criticality that this limitation demarks a patentable distinction over what has already been patented in the art. Thus one of ordinary skill in the art would have been motivated to use the capsules taught by Tanaka because they are rupturable and the components are release upon pressure, furthermore, they appear to offer the same benefits in terms of ease of use, smooth feel, skin sensation, and moisturizing as those described in the instant application. The Tanaka reference clearly reads on a cosmetic preparation comprising hydrophobic particle materials; however, it does not speak to the actual particle sizes as claimed in claims 24, 27, 30, and 33. Absent any evidence to the contrary, these materials are deemed to have appropriate size

diameters. Applicant is reminded that where the general conditions of the claims are met, burden is shitted to applicant to provide a patentable distinction.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive. It is first noted that the instant claims are product by process type claims. Applicant's attention is thereby referred to MPEP 2113 which discussed the examination and interpretation of product by process claim limitations. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Furthermore, the Patent Office bears a lesser burden of proof in making out a case of *prima facie* obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. *In re Fessmann,* 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi,* 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983) . The prior art discloses a cosmetic composition comprising the aqueous gel cores in a cosmetically acceptable ingredient. Applicant is

invited to present evidence as to the structural differences between the prior art composition and the instant claims deemed critical to the invention, as asserted in the arguments presented. Arguments by Applicant do not replace evidence when evidence is needed.

Claims 8-9 and 27-28, and 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reyes (US Patent 3,405,071) in view of Deubzer et al. (US Patent 6,251,313).

Reyes teaches microcapsules and a process of making microcapsules comprising an outer hydrophobic polymer layer grafted onto a gelled hydrophilic polymer containing an encapsulated polar solution (column 1, lines 10-42; col. 2, line 3-35, Examples). The hydrophilic polymer, in the internal phase, is gelled to form a microscopic particle or core containing the aqueous solution to be encapsulated. Suitable gellable hydrophils include, for example, agar agar, alginic acid and derivatives, casein, starch, locust bean gum, polyvinyl alcohol and other gellable colloids. Where alkali solutions are being encapsulated, hydrophilic colloids such as natural gum, starch and the like may be in the formulation to increase the initial water holding capacity (column 4, lines 24-33). Reyes describes suitable hydrophobic polymers, for example, vinyl, acrylate, styrene, polyethylene, polypropylene polymers, natural and synthetic rubbers, cellophane and cellulose derivatives. The polymeric materials should exhibit stability (column 3, lines 20-42; column 4, lines 12-23).

According to Reyes, to produce microcapsules, which are water-resistant, or water vapor impermeable, it is essential that the grated monomer or polymer forming the outer surface of the microcapsule product be a hydrophobic material (column 4, lines 1-5). As a particular example of the process, Figure 1 demonstrates an emulsion formed in step 10 comprising a solution of gullible hydrophilic polymer and aqueous solution goes the internal phase and an immiscible organic or no polar solvent containing a hydrophobic polymer-forming monomer and a hydrophobic polymer as the external phase (column 4, lines 6-12). Likewise, Figure 2 demonstrates a technique utilizing hydrophilic materials that comprise microscopic particles of casein, agar, agonic cid derivatives such as sodium alginate, starch, locust bean gum, polyvinyl alcohol and like gullible colloids (column 4, line 66 - column 5, line 6). Example 1 at column 5 demonstrates a water-in-oil emulsion incorporating polybutene. After thoroughly mixing under nitrogen, casein and triethanolamine were added to result in casein particles containing appreciable amounts of polybutene. Reyes do not explicitly teach the instant particle diameters. However, in the absence of showing the criticality of the instant particle diameter, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable particle diameters through routine or manipulative experimentation to obtain optimal results, as these are indeed variable parameters attainable within the art. The prior art clearly recognizes and teaches microcapsules wherein hydrophilic polymeric materials are coated with hydrophobic particles.

Regarding the 'freeze-shattering' of the gel, no criticality is seen in the use of Applicant's freeze shattering of the gel since the prior art teaches obtaining a similar capsule that releases the components upon pressure. Moreover, Reyes teaches capsule formulating techniques involving the use of nitrogen (see Example 1). Reyes teaches microcapsules formed of an outer hydrophobic polymer layer grafted onto a gelled hydrophilic polymer containing an encapsulated polar solution. Reyes teaches that the coated microcapsules are used in the paper industry whereby depending on the materials to be encapsulated, markings are made by application of pressure (column 2, line 27-62). Reyes does not teach that the microcapsule is used for cosmetic applications.

Deubzer discloses a process for the preparation of microencapsulated products, such as microcapsules having shell walls of organopolysiloxane surrounding a solid or liquid core material, wherein the microcapsules are used for various applications including cosmetics, care products, coatings and paper and construction industries (column 6, lines 15-25; Abstract). Materials to be encapsulated include water and water-soluble materials such as gelatin, agar, pectins, celluloses and the like (column 3, lines 47-54; column, lines 57-60). The microcapsules are used in cosmetics and are comprised of a particle-powder such that when pressure is applied, oily contents are released (column 6, lines 21-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the coated microcapsules of Deubzer et al. within the microcapsules of Reyes, because Deubzer et al. explicitly teach a coated

microcapsule formulation that encapsulates solid/liquid materials that is advantageously used for multiple applications, including cosmetic applications, as well as paper and construction industries. The expected result would be an improved, coated microencapsulated product that is conveniently employed in an array of applications for versatility of use and ease for the consumer.

Response to Arguments

Applicant did not provide any remarks about above rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is

(571)272-9039. The examiner can normally be reached on 7:30am-4pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/
Examiner, Art Unit 1615

/Michael P Woodward/
Supervisory Patent Examiner, Art Unit 1615